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09/868,435	10/01/2001	Daniel Doll-Steinberg	4267-4000	1453

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EXAMINER

SHERR, CRISTINA O

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,435

Applicant(s)

DOLL-STEINBERG, DANIEL

Examiner

Cristina Owen Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 and 50-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-31 and 50-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is in response to applicant's amendment filed April 27, 2006.

Claims 26-31 and 50 have been amended. Claims 26-31 and 50-75 are currently pending in this case.

Response to Arguments

2. Applicant's arguments filed April 27, 2006 have been fully considered but they are not persuasive.

3. Applicant argues, with respect to independent claims 26 and 50 that nothing in the cited art teaches or suggests a retail store environment or point of sale environment in which the customer/client chooses a product which does not yet exist in a material form and pays for it. The production process can only be initiated by verified staff and then can only proceed after payment. The customer/client receives the complete and packaged product after a few minutes of waiting and the process does not even require the customer/client to have a computer platform at all.

4. Although none of the cited references show or suggest all the limitations describes, it is the combination of the references that shows all said limitations. Slik et al (See Figs. 3-6, 16, Col. 18, lines 30-55) disclose a means for distributing digital data with a remote licensing center issuing a release code to a local media store substantially as claimed. The differences between the above and the claimed invention, is the use of explicit customer selected information. It is noted that the user selection of digital data and subsequent data exchange prior to purchase is functionally equivalent to the claim limitations. Each of Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 1) disclose a few minutes of waiting and the process does not even require

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Fig. 2-10) shows the manufacture of software based on user selection. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Slik et al because user selection and naming are conventional functional equivalents of the claim limitations.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26-31 and 50-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slik et al (5809145) in view of either Grundy (5291598) or Richardson (5490216).

7. Regarding claim 26 –

Slik et al (See Figs. 3-6, 16, Col. 18, lines 30-55) disclose a means for distributing digital data with a remote licensing center issuing a release code to a local media store substantially as claimed. The differences between the above and the claimed invention, is the use of explicit customer selected information. It is noted that the user selection of digital data and subsequent data exchange prior to purchase is functionally equivalent to the claim limitations. Each of Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection. It would have been obvious to the person having ordinary skill in this art to provide a similar

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arrangement for Slik et al because user selection and naming are conventional functional equivalents of the claim limitations.

8. Regarding the print limitations of claim 27, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures that are conventional functional equivalents of the claim limitations.

9. Regarding protocol limitations of claim 28, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures that is conventional functional equivalent of the claim limitations.

10. Regarding personalization limitations of claim 29, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection and thus personalized that is conventional functional equivalent of the claim limitations.

11. Regarding the cd limitations of claim 30, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection on cd media that are conventional functional equivalents of the claim limitations.

12. Regarding print limitations of claim 31 Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures (which can employ any of the ubiquitous cd labeling applets) that is conventional functional, equivalent of the claim limitations.

13. Regarding claim 50 –
personalized that is conventional functional equivalent of the claim

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Slik et al (See Figs. 3-6, 16, Col. 18, lines 30-55) disclose a method for distributing digital data with a remote licensing center issuing a release code to a local media store substantially as claimed. The differences between the above and the claimed invention is the use of explicit customer selected information. It is noted that the user selection of digital data and subsequent data exchange prior to purchase is functionally equivalent to the claim limitations. Each of Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Slik et al because user selection and naming are conventional functional equivalents of the claim limitations.

14. Regarding the user limitations of claim 51, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection on cd media that are conventional functional equivalents of the claim limitations.

15. Regarding the print limitations of claim 52, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures that are conventional functional equivalents of the claim limitations.

16. Regarding protocol limitations of claim 53, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures that is conventional functional equivalent of the claim limitations.

Regarding Fig. 2-10) shows the manufacture of software based on user selection.

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17. Regarding the storage limitations of claims 54-55, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection on cd media that are conventional functional equivalents of the claim limitations.

18. Regarding print limitations of claims 56-57, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures (which can employ any of the ubiquitous cd labeling applets) that is conventional functional equivalent of the claim limitations.

19. Regarding authenticity limitations of claims 58-59, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection and thus personalized that is conventional functional equivalent of the claim limitations.

20. Regarding print limitations of claims 60-62, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures (which can employ any of the ubiquitous cd labeling applets) that is conventional functional equivalent of the claim limitations.

21. Regarding the sale limitations of claims 63-68, Slik et al (See Figs. 3-6, 16, Col. 18, lines 30-55) disclose a method for distributing digital data with a remote licensing center issuing a release code to a local media store that is conventional functional equivalent of the claim limitations.

22. Regarding sale limitations of claims 69-75, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection

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and thus personalized that is conventional functional equivalent of the claim limitations because of the standard sale types enumerated.

23. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

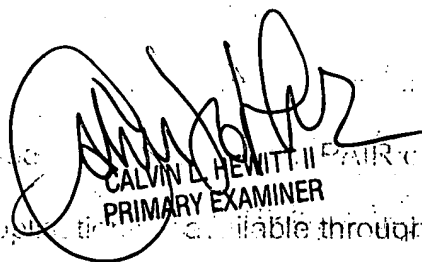
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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

COS, 07/17/06


CALVIN L. HEWITT II
PRIMARY EXAMINER

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